

## REMARKS

In the Office Action, claims 10-48, 66, 67, and 69-97 were pending. Claims 10-48, 66, 67, and 69-97 were rejected. In this response, no claims have been added. Claims 11-27, 29-47, and 66-67 have been cancelled. Claims 86 and 93 have been amended without introducing any new matter. Thus, claims 10, 28, 48, 69-97 remain pending. Reconsideration of this application, in light of the following arguments, is respectfully requested.

The Examiner has rejected claims 10 and 28 under the judicially created doctrine of double patenting as being unpatentable over U.S. Patent No. 6,785,708. It is respectfully submitted that a terminal disclaimer will be submitted when the present application is in condition for allowance.

Claims 10, 28, 48, 69-97 are rejected under 35 U.S.C. § 103(a) as being unpatentable over an article entitled "VolanoChat Java solution turns ordinary Web sites into interactive money makers", Business Wire, pp1-2 ("Volano"), in view of U.S. Patent No. 5,572,619 of Judson (hereinafter "Judson"), further in view of U.S. Patent No. 5,862,330 of Anupam et al. (hereinafter "Anupam"), and further in view of "The Sociable Web" by Donath et al. (hereinafter "Donath").

With respect to independent claim 10, the applicants claim:

10. A method for embedding chat functions in a Web page, comprising:
  - in response to a command received by a computer, establishing a browser region including a browser frame controlled by a browser client on a display device;
  - establishing a chat region controlled by a chat client within the browser region on the display device contemporaneously with the browser region, the chat region being a real time continuously open bi-directional communications chat region synchronized with the browser region;
  - in response to receiving chat content including a link to a web page, the chat client effecting displaying of the chat content in the chat region;

in response to detecting selection, by a user of the display device, of the link displayed in the chat region, the chat client invoking the browser client with the link; and  
in response to the invoking, the browser client obtaining from a server the web page that corresponds to the link and displaying the obtained web page in the browser frame. (Emphasis Added)

The Applicants respectfully disagree with the rejection because the references, alone or in combination fail to describe or suggest each and every element as claimed in claim 10.

Volano describes chat and chat server software for embedding and controlling chat in a web page without requiring a special browser (Volano, page 1). Volano then describes that the software can embed banner advertisements within a chatroom (Volano, pages 1-2). However, Volano is merely an advertisement that discusses chat and server software at a very high level without describing linking or synchronizing chat and browser functions within one browser region of a general purpose web browser.

Anupam describes a “controller” within an internet server for controlling collaborative web browsing sessions, including chat, without requiring special web browsers (Anupam, Abstract and Column 2, line 18 to Column 3, line 43). If a browsing session is collaborative, then the originator of the collaborative session controls the browsing of all participants of the browsing session (Anupam, Column 4, lines 6-26). Thus, Anupam neither discusses users selecting links nor a browser to synchronize link selection within a chat session and browsing functions, because all browsing is controlled by the originator.

Judson merely describes that when a link is selected, a web browser displays an image or icon while a picture is loading (Judson, Column 6, lines 13-61). As such, merely describes the implementation of links that are associated with “information objects” that define what should be displayed while an image is loaded by a web browser. Judson, therefore, fails to describe or suggest chat functions within a web browser or

synchronizing chat and browsing functions when a user selects a link within a chat region.

Furthermore, Donath describes a special web browser for implementing a sociable web environment (Donath, page 2). As described by Donath, a user can anchor to a web page and communicate via chat with others on a web page (Donath, pages 2-3). In the sociable web browser of Donath, a user can chat with others and include links within the sociable web chat session. If a user selects a link within a chat session, the user will follow the link (Donath, page 3). However, merely describing following a link fails to describe a browser with synchronized chat and browsing functions.

The Applicants, however, claim “establishing a chat region ... synchronized with the browser region; [so that] ... in response to detecting selection, by a user of the display device, of the link displayed in the chat region, the chat client invoking the browser client with the link; and in response to the invoking, the browser client obtaining from a server the web page that corresponds to the link and displaying the obtained web page in the browser frame.” That is, a user can select a link in a chat region to display a web page in the browser frame of a browser region, while continuing to chat. It is respectfully submitted that the cited references fail to disclose or suggest, alone or in combination, the above limitations.

The Examiner argued that “Donath’s chat regions on page 2-3 clearly demonstrate the synchronization of chat and browsing functions as illustrated in application claim language” (Final Office Action, pages 11-12). The Applicants respectfully disagree. As noted above, the Applicants claim “in response to detecting selection, by a user of the display device, of the link displayed in the chat region, the chat client invoking the browser client with the link; and in response to the invoking, the browser client obtaining from a server the web page that corresponds to the link and displaying the obtained web

page in the browser frame.” Donath specifically describes anchoring to a web page to retain a presence on a web page (Donath, page 2, Virtual Location). After a user anchors to a web page, he may “wander” to other web pages while continuing to chat on his anchor page (Donath, pages 2-3). Thus, a person may browse independently of their current chat session without losing the anchor to their virtual home location. As such, Donath merely describes synchronizing chat functions without also synchronizing browser functions, as claimed by the Applicants.

Therefore, for at least the reasons discussed above, it is respectfully submitted that independent claim 10 is patentable over the cited references. The Applicants respectfully request withdrawal of the rejections.

The Examiner further set forth that the references are related, and thus the combination is proper (Office Action, page 12). However, the Applicants submit that one skilled in the art would not be motivated to combine Donath with the remaining references. In order to combine the references, there must be “some teaching, suggestion, or motivation to do so” found in the prior art (MPEP § 2143.01[I]). Further, the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (MPEP § 2143.01[III], emphasis added). Volano, Anupam, and Judson each describe various applications, as discussed above, which are specifically designed for implementation in a standard web browser. Furthermore, each reference discusses its benefit in terms of not requiring a specially created browser or html encoded web pages, thus enabling the use of any number of standard web browsers (*See* Volano, page 1, paragraphs 1-2; Judson, column 3, line 44 to column 4, line 4; Anupam, column 2, lines 18-38). However, Donath explicitly recites “the [sociable web] project has been discontinued [because] a service that requires a non-standard browser is not a practical

solution” (Donath, <http://judith.www.media.mit.edu/SocialWeb/CurrentStatus.html>, emphasis added). Thus, Donath explicitly teaches away from the combination since Donath admits that a non-standard browser is required. As such, one skilled in the art would not be motivated to combine Volano, Anupam, and Judson with Donath (e.g. four different and inconsistent references), for at least the reasons discussed above. Even if, for the sake of argument, they were combined, such a combination still lacks the limitation set forth above. Thus, for the reasons set forth above, claim 1 is patentable over the cited references.

Similarly, independent claims 28 and 48 include limitations similar to those recited in claim 10. Thus, for the reasons similar to those discussed above, independent claims 28 and 48 are patentable over the cited references.

Claim 86 has been amended to substantially include the limitations contained in claim 10. In addition to the discussion above, with respect to claim 86, the Applicants claim:

A method for embedding chat functions in a Web page, comprising:

- in response to a command received by a computer, establishing a browser region including a browser frame controlled by a browser client on a display device;
- establishing a chat region controlled by a chat client within the browser region on the display device contemporaneously with the browser region, the chat region being a real time continuously open bi-directional communications chat region synchronized with the browser region;
- in response to receiving chat content including a link to a web page, the chat client effecting displaying of the chat content in the chat region;
- in response to detecting selection, by a user of the display device, of the link displayed in the chat region, the chat client invoking the browser client with the link;
- in response to the invoking, the browser client obtaining from a server the web page that corresponds to the link and displaying the obtained web page in the browser frame;
- in response to detecting selection by the user of a target, requesting from at least one server a chat content of a chat session associated with the target and a web page associated with the target;

in response to the request, receiving from the at least one server the chat content of the chat session associated with the target and the web page associated with the target; and

in response to the receiving, displaying the chat content of the chat session associated with the target in the chat region and simultaneously displaying the web page associated with the target in the browser region.

The Applicants respectfully submit that the references, alone or in combination, fail to describe or suggest each and every element of amended claim 86.

As discussed above Volano describes embedding a banner advertisement in a web page. Anupam includes a description of a controller that can manipulate a collaborative browsing session. Judson merely provides a system for displaying an icon while an image is being loaded on a web page. Finally, Donath describes a sociable web where users can continue to chat even though they click through links on a web page.

The Applicants, however, claim in amended claim 86:

in response to detecting selection by the user of a target, requesting from at least one server a chat content of a chat session associated with the target and a web page associated with the target;

in response to the request, receiving from the at least one server the chat content of the chat session associated with the target and the web page associated with the target; and

in response to the receiving, displaying the chat content of the chat session associated with the target in the chat region and simultaneously displaying the web page associated with the target in the browser region.

The Applicants submit that the references, alone or in combination, fail to describe or suggest each and every element claimed in amended claim 86.

Volano merely describes embedding chat within a web page whereas Judson provides for the display of an icon. Further, Anupam provides for a single controller to control the browsing of other users. Finally, Donath describes allowing a chat session to continue despite a user deciding to browse pages outside of a chat session. The Applicants, however, claim chat content and a web page associated with a target such that

in response to selection of the target, both the chat session and the web page are changed to those associated with the target. Because the references, alone or in combination, fail to describe or suggest chat content and a web page associated with a user-selectable target, and the references fail to describe simultaneous display of both the associated chat content and web page when the target is selected, claim 86 is not rendered obvious in view of the references. The Applicants respectfully submit that claim 86, as amended, is in condition for allowance, and such action is earnestly solicited.

Similarly, independent claim 93, as amended, includes limitations similar to those recited in claim 86. Thus, for the reasons similar to those discussed above, independent claim 93 is also patentable over the cited references.

Given that the remaining claims depend from one of the above independent claims, at least for the reasons similar to those discussed above, it is respectfully submitted that the rest of the claims are patentable over the cited references. Withdrawal of the rejections is respectfully submitted.


## CONCLUSION

In view of the foregoing, Applicant respectfully submits the present application is now in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

Please charge Deposit Account No. 02-2666 for any shortage of fees in connection with this response.

Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 3/31/04



Michael J. Mallie  
Attorney for Applicant  
Reg. No. 36,591

12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, California 90025-1026  
(408) 720-8300